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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/392,585 09/09/99 DESLANDES

T Q055716

SUGHRUE MION ZINN MACPEAK & SEAS  
2100 PENNSYLVANIA AVENUE NW  
SUITE 800  
WASHINGTON DC 20037-3202

TM02/0716

EXAMINER

VAUGHN JR, W

ART UNIT

PAPER NUMBER

2152

DATE MAILED:

07/16/01

13

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

GM

# Office Action Summary

Application No.

09/392,585

Applicant(s)

deslandes et al.

Examiner

William C. Vaughn, Jr.

Art Unit

2152

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. This Action is in response to the Reply and Amendment received 03 May 2001.

#### *Continued Prosecution Application*

2. The request filed on 03 May 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/392,585 is acceptable and a CPA has been established. An action on the CPA follows.

3. The application has been examined. **Original claims 1-12** are pending. The objections and rejections cited are as stated below:

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the user entering into the supervision terminal an identifier (this feature is stated in steps 100-150 on pages 5-6, but not featured in any of the Figures) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

#### *Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. **Claim 1** are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Applicant's specification lacks the proper teachings that is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicant claims selecting which failed objects should be loaded. Applicant describes implicitly but not explicitly the way in which a franking machine is off line as well as isolated from a network and operating independently [see Applicant's specification, abstract and page 4]. However, it is not disclosed nor taught as to how the system is electrically isolated. But the details essential to the making of applicant's invention is not set forth within the specification. It would required undue experimentation for one of ordinary skill in the networking art at the time the invention to determine the details of how the franking machine is electrically isolated.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pierce et al. (Pierce), U.S. Patent No. 6,151,591 in view of Bernard et al. (Bernard), U.S. Patent No 5,717,596.

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9. Regarding **independent claims 1 and 12**, Pierce discloses the invention substantially as claimed. Pierce discloses a process for monitoring the consumption of a plurality of franking machines [item 10] through a public communication network, [Figure 1], the process comprising the steps of first establishing a link with a management server through the public network, by means of at least one supervision terminal [see Pierce, Col. 5, lines 15-67] and then proceeding with an exchange of data between the terminal and the server during which the user acquires at the supervision terminal a current invoicing index and in return receives a code of authorization to frank in order to validate the subsequent frankings [see Pierce, Col. 6, lines 1-67, Col. 7, lines 1-67, Col. 8, lines 1-67]. However Pierce does not explicitly disclose franking machine being electrically isolated from the public communications network.

10. In the same field of endeavor, Bernard discloses in an analogous art (e.g. method and system for franking, accounting, and billing of mail services). Bernard discloses franking machine being electrically isolated from the public communication network [see Bernard, Col. 3, lines 50-63].

11. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to incorporated Bernard's teachings method and system for franking, accounting, and billing of mail services with the teachings of Pierce, for the purpose of preventing fraudulent and inadvertent dispensing of postage [see Bernard, Col. 2, lines 34-40].

By this rationale **independent claims 1 and 12** are rejected.

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12. **Dependent claims 2-11**, recite features which are common in the networking art and are taught within the figures of Pierce-Bernard. By this rationale **dependent claims 2-11** are rejected.

13. It is the Examiner's position that the Applicant's claims are unduly broad in view of the breadth and depth of the franking machine art, which has developed over the past twenty five years. In particular, Pitney Bowes holds a number of art defining patents in this technology area. In order that the Examiner properly focus the examination on the subject matter as claimed. Applicant is advised to read and consider the prior art not only used in the rejection, but other prior art cited and to amend the claims with subject matter defining clearly the features of the invention over the prior art as a whole.

#### *Conclusion*

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (703) 306-9129. The examiner can normally be reached on Monday through Friday from 8:00 to 4:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart, can be reached on (703) 305-4815. The fax phone number for this Group is (703) 305-9731 (for informal or draft communications, please label **"PROPOSED"** or **"DRAFT"**). Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

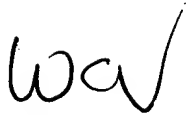
**Any response to this action should be mailed to:**

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Commissioner of Patents and Trademarks  
Washington, DC 20231

**OR:**

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal  
Driver, Arlington, VA., Sixth Floor (Receptionist)



*WCV*  
*Patent Examiner*  
*AU 2152*  
*July 12, 2001*



**ROBERT B. HARRELL**  
**PRIMARY EXAMINER**